REMARKS

Claims 1-20 are pending in this application.

Claims 1-20 have been finally rejected.

No claims have been allowed.

No claims have been amended in this Response.

Claims 1-20 remain in the application.

Reconsideration of Claims 1-20 is respectfully requested.

35 U.S.C. § 103(a) Obviousness

In the October 22, 2003 Office Action the Examiner finally rejected Claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,411,306 to Miller et al. ("*Miller*") in view of United States Patent No. 5,933,130 to Wagner ("*Wagner*"). The Examiner asserted, in essence, that most of the elements recited in Claim 1 are disclosed in the *Miller* reference and that the *Wagner* reference discloses indicator means for presenting a level indicator that indicates the parameter adjustments made by the Applicant's invention. The Applicant respectfully traverses the Examiner's rejections based on the *Miller* reference and the *Wagner* reference.

During *ex parte* examinations of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*,

977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of non-obviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. MPEP § 2142.

The Applicant respectfully submits that the Patent Office has not established a *prima facie* case of obviousness with respect to the Applicant's invention in view of the *Miller* reference and the *Wagner* reference.

The Applicant respectfully directs the Examiner's attention to previously presented Claim 1, which contains unique and novel limitations:

> 1. (Previously presented) An apparatus for processing signals, comprising parameter control means for controlling parameters of said signals, said parameter control means being adapted to cause adjustments to said parameters in response to one of: current ambient factors and properties of said signals, wherein the apparatus further comprises indicator means for presenting a level indicator which is indicative of said adjustments. (Emphasis added).

The Applicant respectfully asserts that the unique and novel limitations of Claim 1 are not disclosed, suggested, or even hinted at in the *Miller* reference or the *Wagner* reference, or in the combination of the *Miller* reference and the *Wagner* reference.

The present invention is directed to a signal processing system and method that comprises (1) parameter control means that adjusts signal parameters in response to one: current ambient factors and the properties of the signals, and (2) indicator means for presenting a level indicator that indicates the signal parameter adjustments. The present invention also comprises (3) user control means for selecting a preferred parameter level from a plurality of preferred parameter levels.

Miller is directed to an apparatus that automatically adjusts the video signal parameters of "luminance" and "contrast" as a function of "ambient" and "surround" luminance. *Miller* states that "It is desirable to provide a display unit that is capable of automatically adjusting luminance and contrast without the need for operator intervention." (*Miller*, Col. 1, Lines 14-18) (Emphasis added).

That is, *Miller* provides an apparatus that automatically calculates values of luminance and contrast based on sensor readings without user input. The *Miller* apparatus is "an apparatus for automatically controlling a display luminance and contrast of a display device . . . " (*Miller*, Col. 3, Lines 9, 10) (Emphasis added).

Miller does not mention using user inputs of the type disclosed in the Applicant's invention and has no element that is analogous to the Applicant's user "user command unit 112." The reason for this is that the automatic system of the *Miller* apparatus has no need of user input. In fact, the *Miller* reference teaches away from using user input. Therefore, *Miller* is not a proper reference for the proposition that it would be obvious to combine user input with the *Miller* apparatus.

The Examiner stated that "Miller et al. does not specifically disclose the indicator means for presenting a level indicator which is indicative of said adjustments." (October 22, 2003 Office Action, Page 3, Lines 5-6). The Applicant agrees that the *Miller* reference does not disclose an indicator means as claimed. The Examiner went on to state that the *Miller* reference discloses a display device "where pop-up or pop-down type windows or GUI for parameter adjustment may be utilized, as is well-known in the art." (October 22, 2003 Office Action, Page 3, Lines 6-8). The Examiner further stated that the *Wagner* reference discloses an anti-eye strain apparatus that automatically adjusts the brightness of a display, comprising an auto brightness control feature within a Graphical Control Interface (GUI). The Examiner stated that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of *Miller* with the teaching of *Wagner* in order to make it easier for the viewer to control or adjust the

parameters of the display according to the desired level. (October 22, 2003 Office Action, Page 3, Lines 15-18). The Applicant respectfully traverses this assertion of the Examiner.

The fact that the *Miller* reference discloses a display device that may be capable of supporting a GUI interface does not suggest using a GUI interface for parameter adjustment in the *Miller* display device. This is especially so where, as previously described, *Miller* expressly teaches an automatic system that has no need of user input. The Applicant respectfully submits that the concept of using an indicator means such as a GUI interface in the *Miller* display device comes not from the *Miller* reference but from the Applicant's claimed invention.

Further, there is no suggestion in the *Wagner* reference to combine the GUI interface of the *Wagner* device with the *Miller* device. *Wagner* recites a graphical user interface (GUI) that allows a user to manually set a "general brightness level" of images to be displayed using a sliding bar. (*Wagner*, Figure 7, Column 9, Lines 6-16). A display then adjusts the brightness level of images being presented to the user based on the general brightness level. (*Wagner*, Column 8, Lines 27-43). For example, the display may vary the brightness level of the images within a range centered at the user's general brightness level. (*Wagner*, Column 8, Lines 27-43). The user's specified brightness level could also represent a maximum or minimum brightness level to be used. (*Wagner*, Column 8, Lines 44-58).

Wagner never mentions that the sliding bar is used to indicate how the brightness level of an image has been altered or adjusted. For example, *Wagner* never mentions varying the brightness level of an image and then presenting the sliding bar to the user. Instead, *Wagner* simply mentions

that the sliding bar allows a user to set the brightness level, and the brightness level is then used to present images to the user. The sliding bar therefore only represents the user's desired brightness level for images to be displayed. The Examiner has stated that it is well known in the art that the "sliding bar indicates the change that has been made to a parameter such as contrast or brightness levels of a display." (October 22, 2003 Office Action, Page 10, Lines 1-3). The Applicant respectfully submits that the Examiner has cited no authority for this assertion. The teaching that a sliding bar always automatically reflects changes in a parameter after the parameter has been changed is not shown or suggested in the cited prior art.

How?

In contrast, Claim 1 recites parameter control means adapted to cause adjustments to parameters of a signal and "indicator means" for "presenting a level indicator which is indicative of [the] adjustments." *Wagner* lacks any mention of an indicator identifying "adjustments" that have been made to a signal. As a result, *Wagner* fails to disclose, teach, or suggest "indicator means" for presenting a level indicator "which is indicative of [the] adjustments."

For these reasons, the proposed *Miller-Wagner* combination fails to disclose, teach, or suggest the Applicant's invention as recited in Claim 1 (and its dependent claims). For similar reasons, the proposed *Miller-Wagner* combination fails to disclose, teach, or suggest the Applicant's invention as recited in Claim 5 (and its dependent claims).

In particular, with respect to Claim 2, the *Wagner* reference does not teach, disclose or even hint at sensing and using current ambient factors to compute parameter adjustments. *Wagner* does not mention using sensors of the type disclosed in the Applicant's invention and has no element that

is analogous to the Applicant's "sensor 113." The reason for this is that the *Wagner* apparatus has no need of sensor input for ambient conditions. The brightness levels of *Wagner* are pre-set and no continual measurements of ambient brightness are made. (*Wagner*, Column 7, Lines 47-54). The general level of brightness is set once (dependent upon ambient lighting) and then no further measurements of the ambient brightness levels are made. The central processing unit of *Wagner* (or the user of the *Wagner* device) may select different levels of brightness with respect to the pre-set general level of brightness. The *Wagner* device, however, unlike the Applicant's invention, does not continually sense and use current ambient factors to compute parameter adjustments. The *Wagner* device has no sensors for sensing current ambient conditions. The *Miller* device has no user control means for a user to select a preferred parameter level from a plurality of parameter levels and has no parameter control means that computes the adjustments as a function of the preferred parameter level and current ambient factors of the signals.

There is no teaching in *Wagner* to suggest combining the *Wagner* device (that requires brightness input values) with an automatically operated system such as the *Miller* device (that has no need of user input). Under the applicable patent law, there must be some teaching, suggestion or motivation to combine the *Miller* reference and the *Wagner* reference. "When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references." *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). "It is insufficient to establish obviousness that the separate elements of an invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the

references." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997). The Applicant respectfully submits that there exists no teaching, suggestion or motivation in the prior art to combine the teachings of the *Miller* reference and the teachings of the *Wagner* reference.

The Applicant respectfully submits that the supposed advantage of making it "easier for the viewer to control or adjust the parameters of display according to the desired level" is an insufficient teaching or suggestion to combine the *Miller* reference and the *Wagner* reference where the *Miller* reference teaches away from the concept of using user input and the *Wagner* reference does not mention using current ambient factors.

When two references are combined the combination of the references must teach or suggest all the claim limitations. In the present case, even if the *Wagner* reference were combined with the *Miller* reference, the combination of the *Wagner* reference and the *Miller* reference would not teach, suggest or even hint at the Applicant's invention. This is because, as previously described, the *Miller* reference does not teach, suggest, or even hint at the Applicant's concept of using user input and the *Wagner* reference does not teach, suggest, or event hint at the Applicant's concept of using current ambient factors.

The Applicant respectfully submits that Claim 1 contains limitations that are not disclosed, taught, or even suggested in the *Miller* reference, in the *Wagner* reference, or in the combination of the *Miller* reference and the *Wagner* reference. This being the case, Claim 1 is allowable over the *Miller* reference and the *Wagner* reference, either alone or in combination. Additionally, Claims 2-4

depend from Claim 1 and contain all of the unique and novel limitations recited in Claim 1. This being the case, Claims 2-4 are patentable over the *Miller* reference and the *Wagner* reference, either alone or in combination.

Claim 2 claims an apparatus in which a user selects a preferred parameter level from a plurality of parameter levels. The *Miller* apparatus automatically selects only one parameter level (i.e., a default level) for luminance and contrast. There is no user input in *Miller* to select a preferred parameter level from a plurality of parameter levels. Claim 6 claims a method in which a user selects a preferred parameter level from a plurality of parameter levels.

Also, independent Claim 5 contains limitations that are analogous to the unique and novel limitations recited in Claim 1. Thus, Claim 5 is patentable over the *Miller* reference and the *Wagner* reference, either alone or in combination. Additionally, Claim 6, which depends from Claim 5, contains all of the unique and novel limitations recited in Claim 5. Thus, Claims 5-6 are both patentable over the *Miller* reference and the *Wagner* reference, either alone or in combination.

Claims 7-11 directly or indirectly depend from amended Claim 1. Therefore, Claims 7-11 contain all of the unique and novel limitations of amended Claim 1. Thus, Claims 7-11 are patentable over the *Miller* reference and the *Wagner* reference, either alone or in combination.

Claims 12-20 directly or indirectly depend from amended Claim 5. Therefore, Claims 12-20 contain all of the unique and novel limitations of amended Claim 5. Thus, Claims 12-20 are patentable over the *Miller* reference and the *Wagner* reference, either alone or in combination.

The Applicant respectfully submits that Claims 1-20 are all patentable, and that the rejections of Claims 1-20 under 35 U.S.C. § 103(a) combining the *Miller* reference and the *Wagner* reference should be withdrawn. The Applicant respectfully requests that Claims 1-20 be passed to issue.

The Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicant reserves the right to submit further arguments in support of his above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

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SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

No fees are believed to be necessary. However, in the event that any fees are required for the prosecution of this application, please charge any necessary fees to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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